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Request For Continued Examination (RCE) Transmittal

Address to:
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Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Application Number	09/852,922
Filing Date	May 10, 2001
First Named Inventor	T. KUROIITA et al.
Art Unit	1652
Examiner Name	Richard G. Hutson
Attorney Docket Number	10089/14

This is a Request for Continued Examination (RCE) under 37 CFR 1.114 of the above-identified application. Request for Continued Examination (RCE) practice under 37 CFR 1.114 does not apply to any utility or plant application filed prior to June 8, 1995, or to any design application. See Instruction Sheet for RCEs (not to be submitted to the USPTO) on page 2.

1. **Submission required under 37 C.F.R. 1.114** Note: If the RCE is proper, any previously filed unentered amendments and amendments enclosed with the RCE will be entered in the order in which they were filed unless applicant instructs otherwise. If applicant does not wish to have any previously filed unentered amendment(s) entered, applicant must request non-entry of such amendment(s).

- a. ☒ Previously submitted. If a final Office action is outstanding, any amendments filed after the final Office action may be considered as a submission even if this box is not checked.

- i. ☐ Consider the arguments in the Appeal Brief or Reply Brief previously filed on
ii. ☒ Other

- b. ☒ Enclosed

- i. ☐ Amendment/Reply
ii. ☐ Affidavit(s)/Declaration(s)
iii. ☐ Information Disclosure Statement (IDS)
iv. ☒ Other Request for Reconsideration

2. **Miscellaneous**

- a. ☐ Suspension of action on the above-identified application is requested under 37 C.F.R. 1.103(c) for a period of _____ months. (Period of suspension shall not exceed 3 months; Fee under 37 C.F.R. 1.17(i) required)

- b. ☐ Other

3. **Fees** The RCE fee under 37 C.F.R. 1.17(e) is required by 37 C.F.R. 1.114 when the RCE is filed.

- a. ☒ The Director is hereby authorized to charge the following fees, or credit any overpayments, to Deposit Account No. 11-0600

- i. ☒ RCE fee required under 37 C.F.R. 1.17(e)
ii. ☐ Extension of time fee (37 C.F.R. 1.136 and 1.17)
iii. ☐ Other

- b. ☐ Check in the amount of \$ _____ enclosed

- c. ☐ Payment by credit card (Form PTO-2038 enclosed)

WARNING: Information on this form may become public. Credit card information should not be included on this form. Provide credit card information and authorization on PTO-2038.

SIGNATURE OF APPLICANT, ATTORNEY, OR AGENT REQUIRED

Name (Print /Type)	King L. Wong	Registration No. (Attorney/Agent)	37,500
Signature	King L. Wong	Date	September 8, 2004

CERTIFICATE OF MAILING OR TRANSMISSION

I hereby certify that this correspondence is being deposited with the United States Postal Service with sufficient postage as first class mail in an envelope addressed to: Mail Stop RCE, Commissioner for Patents, P. O. Box 1450, Alexandria, VA 22313-1450, or facsimile transmitted to the U.S. Patent and Trademark Office on the date shown below:

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This collection of information is required by 37 CFR 1.114. The information is required to obtain or retain a benefit by the public which is to file (and by the USPTO to process) an application. Confidentiality is governed by 35 U.S.C. 122 and 37 CFR 1.14. This collection is estimated to take 12 minutes to complete, including gathering, preparing, and submitting the completed application form to the USPTO. Time will vary depending upon the individual case. Any comments on the amount of time you require to complete this form and/or suggestions for reducing this burden, should be sent to the Chief Information Officer, U.S. Patent and Trademark Office, U.S. Department of Commerce, P.O. Box 1450, Alexandria, VA 22313-1450. DO NOT SEND FEES OR COMPLETED FORMS TO THIS ADDRESS. SEND TO: Mail Stop RCE, Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450.

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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Appl. No. : 09/852,922 Confirmation No. 5846
Applicant : T. KUROITA, et al.
Filed : May 10, 2001
Art Unit : 1652
Examiner : Richard G. Hutson

Docket No. : 10089/14
Customer No. : 23838

FOR: MODIFIED THERMOSTABLE DNA POLYMERASE

Mail Stop RCE
Commissioner of Patents
Box 1450
Alexandria, VA 22313

REQUEST FOR RECONSIDERATION

SIR:

Applicants request that the Amendment filed on June 29, 2004 be entered for the Request for Continued Examination filed herewith. Applicants also request reconsideration of the Final Office Action.

Applicants request that claim 31 be rejoined with the other claims in the examination on the merits in view of the reasoning presented in pages 8 and 9 of the Amendment of June 29, 2004.

Applicants urge that the Patent Office has not provided any reasonable explanation of how chemical synthesis would improve the amplification efficiency and/or fidelity of a thermostable DNA polymerase as alleged by the Final Office Action.

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Applicants request that the indefiniteness rejection of claims 4-12 and 32 be withdrawn. In light of the amendments to these claims, a person skilled in the art would understand the scope of these claims.

Applicants also request that the written description rejection of claims 1-12, 25-28, 30 and 32-38 be withdrawn. The Advisory Action of August 2, 2004 asserts that applicants' explanations in the Amendment concerning the structure/function relationship disclosed in the specification "is minor and insufficient to describe the breadth of the claimed invention." Applicants respectfully disagree. The Amendment explains that the specification discloses the function of the DNA polymerase wherein the histidine residue is replaced by an acidic, basic or neutral amino acid. The replacement of the acidic, basic or neutral amino acid covers the entire breadth of the claims. Thus, the explanation is not minor and should be sufficient to cover the full scope of the claims. Similarly, applicants submit that there is no legal support for the Advisory Action's reason for maintaining the enablement rejection. Withdrawal of the rejections under 35 U.S.C. 112, first paragraph, is requested.

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Conclusion

In light of the above reasoning, applicants submit that the application is in a condition for allowance. A Notice of Allowance is believed in order.

In the event that this paper is deemed not timely, applicants petition for an appropriate extension of time. The petition fee, and any other fees that may be required in relation to the filing of this paper, can be charged to Deposit Account No. 11-0600, referencing Docket No. 10089/14.

Respectfully Submitted,

KENYON & KENYON

Date: September 8, 2004

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